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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/578,777	05/25/2000	Michael W. Medin	06948.105013	5814

7590

04/10/2002

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EXAMINER

ASSAF, FAYEZ G

ART UNIT

PAPER NUMBER

2872

DATE MAILED: 04/10/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/578,777

Applicant(s)

MEDIN ET AL.

Examiner

Fayez G. Assaf

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-59 is/are pending in the application.
- 4a) Of the above claim(s) 26-59 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 12-25 is/are allowed.
- 6) ☒ Claim(s) 1-3 and 9-11 is/are rejected.
- 7) ☒ Claim(s) 4-8 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 May 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4, 7.
- ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other:

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**DETAILED ACTION**

***Election/Restrictions***

Applicant's election with traverse of Group I: claims 1-25 in Paper No. 9 is acknowledged. The traversal is on the ground(s) that examining the entire application can be made without serious burden, because the subject matter of Group I and II is substantially related. This is not found persuasive because the inventions have acquired a separate status in the art as shown by their different classification.

The requirement is still deemed proper and is therefore made FINAL.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the

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examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 9-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Kobayashi et al. (US 6111688).

Kobayashi discloses an optical amplifier comprising, a light detector (64 of Fig. 4) for converting light energy into electrical energy, and a laser device (54 of Fig. 4) for outputting modulated light energy in accordance with the electrical energy [by means of elements 60, 66 and 68 of Fig. 4]. The amplifier comprises an optical feedback assembly coupled to an optical waveguide, and having a Bragg grating (52 of Fig. 4).

Claims 1-3 are rejected under 35 U.S.C. 102(e) as being anticipated by anticipated by Yoshida (US 5917623).

Yoshida discloses an optical add-drop multiplexing device (see Fig. 3) comprising, a wavelength adapter module (21 of Fig. 3) for transmitting unstabilized non-monochromatic or monochromatic light energy into one or more channels of stabilized monochromatic light energy (i.e. newly added power stabilized signal) having one or more predefined wavelength

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regions, and a filter module (see circuit between add and drop ports) for at least one of dropping, adding, and recombining one or more channels of stabilized monochromatic light energy having one or more predefined wavelength regions.

It is noted that the recitation that the information traffic carried by an optical waveguide being substantially increased has not been patentable weight, since it has been held that the functional "whereby" statement does not define any structure and accordingly can not serve to distinguish. In re Mason, 114 USPQ 127, 44 CCPA 937 (1957).

Regarding claims 2 and 3, Yoshida discloses the adapter comprising a light detector (26 of Fig. 3) for converting light energy into electrical energy, and a laser device (24 of Fig. 3) for outputting modulated light energy in accordance with the electrical energy, wherein the adapter module further comprises an optical feedback assembly coupled to an optical waveguide.

#### ***Allowable Subject Matter***

Claims 4-8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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Claim 4 is allowable over the prior art for at least the reason that the prior art fails to teach or reasonably suggest the optical feed back assembly comprising a Bragg grating as set forth in the claimed combination.

Claim 5 is allowable over the prior art for at least the reason that the prior art fails to teach or reasonably suggest the laser diode initially producing light energy at approximately 1310 or 1550 nm wavelength region prior to stabilization as set forth in the claimed combination.

Claims 6 and 7 are allowable over the prior art for at least the reason that the prior art fails to teach or reasonably suggest the plurality of filters disposed adjacent to the planar light guide circuit as set forth in the claimed combination.

Claims 8 and 12-25 are allowable over the prior art for at least the reason that the prior art fails to teach or reasonably suggest the SONET network having a module for transforming unstabilized light energy into stabilized monochromatic light energy having one or more predefined wavelength region as set forth in the claimed combination.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Sugaya (US 6038061).

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Mizrahi et al. (US 6249365 B1).

Nasu et al. (US 6282340 B1).

**Conclusion**

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Fayez Assaf whose telephone number is (703) 306-5526. The fax number for the organization where this application or proceeding is assigned is (703) 308-7722.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

  
Fayez Assaf

4/5/02

  
**Cassandra Spyrou**  
**Supervisory Patent Examiner**  
**Technology Center 2800**